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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,644	04/02/2004	Kia Silverbrook	HYC009US	9575
24011	7590	01/17/2006	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, NSW 2041 AUSTRALIA			LE, THIEN MINH	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/815,644

Applicant(s)

SILVERBROOK ET AL.

Examiner

Thien M. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-8, 11-12, 15-18, 22-23, 26-27, 30-34, 38-40 is/are rejected.
- 7) ☒ Claim(s) 4-6, 9, 10, 13, 14, 19-21, 24, 25, 28, 29, 35-37 and 41-50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/2004</u> . | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

The information disclosure statements filed on 10/7/2004 and 10/14/2004 have been entered. Claims 1-50 are presented for examination.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-8, 11-12, 15-18, 22-23, 26-27, 30-34, and 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas et al. (Thomas et al. - PG PUB 2002/0091571; herein after referred to as Thomas).

Thomas discloses the methods and systems for electronic coupon issuance transmission and management. According to Thomas, “an electronic coupon includes various types of information relevant to redemption, such as information identifying the discounted product, the amount of the discount, the expiration date, and any limitations on the use of the electronic coupon. The electronic coupons may further include other valuable information, such as the total purchase price of the product, the manufacturer identification, the vendor identification, the purchaser identification, the product description, the purchase date, the purchase time, the method of purchase, and/or any other additional information that may be beneficial, such as purchaser profile information, vendor profile information, authorization

information, coupon management information, and/or other transactional information. One implementation of the present invention includes electronic coupons that store itemized information so that the electronic coupons may be automatically categorized.”

Regarding claims 1, 7, 18, 22, 33, Thomas discloses a method and systems for electronic coupon issuance comprising the steps of: (i) using a sensing device for sensing one or a plurality of coupons (serve as the claimed tokens) (see paragraph 0084-0087); (ii) forwarding the token data to a computing device for retrieving additional information regarding the tokens (see figure 2 for computer device 60); (iii) forwarding the tokens and additional information to a vendor (administrator) for processing and redeeming the tokens (see figure 2, the vendor computing device). As can be seen, Thomas discloses the claimed invention.

Regarding claims 2, 8, 11, 12, 23, and 26-27, see paragraph 0020 wherein Thomas discloses that the information pertaining to the tokens comprising: redemption information, discounted product information, expiration date, any limitation of the use of the tokens, and other valuable information; and thus would meet all limitations set forth in this claim.

Regarding claim 3, see the discussions regarding claims 1-2. Some information of the tokens are in electronic or code forms, i.e. bar code forms, electronic information; and thus would meet all limitations set forth in this claim.

Regarding claims 15 and 30, see the discussions regarding claim 1 and figures 2-3 of Thomas. With regarding to figure 3, Thomas discloses that “the various electronic

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coupons are analyzed for providing the greatest benefit to the user at step 92. For example, indicating the products or services that are to be purchased and the quantities may enable information processing to occur that recommends when, where, what or how a particular product is purchased, including the about of the product, to maximize the benefit for the user.” Thomas further discloses the steps of obtaining information from the sensing devices, sending requests for information and approval of the redeeming tokens (see paragraphs 0085-0086).

Regarding claims 16-17, 31-32, and 38-40, see the discussions regarding claims 1 and 2. Also see the discussions regarding figure 2.

Regarding claim 34, Thomas discloses that the tokens may comprise UPC bar codes, which are considered as the telecommunication addresses for retrieving tokens information from a remotely located tokens database 60 as shown in figure 2.

### ***Allowable Subject Matter***

Claims 4-6, 9-10, 13, 14, 19-21, 24-25, 28-29, 35-37, and 41-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fail to disclose the method of redeeming tokens comprising the method steps set forth in claim 1 and further comprising the step of sensing hand-

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written information as recited in claim 4. The prior art also fails to disclose the set of redeeming the tokens and further comprising the method of generating movement data indicative of movement of the sensing device relative to the labels in the manners as recited in claims 5-6.

The prior art also fails to disclose the limitations of claim 9 which further comprising the step of receiving alias ID with the token redemption information.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Le, Thien Minh**  
**Primary Examiner**  
**Art Unit 2876**  
**January 9, 2006**